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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,633	05/06/2005	Rolf Kawa	C 2609 PCT/US	8614
23657	7590	11/29/2007	EXAMINER	
COGNIS CORPORATION PATENT DEPARTMENT 300 BROOKSIDE AVENUE AMBLER, PA 19002			SULLIVAN, DANIELLE D	
			ART UNIT	PAPER NUMBER
			1616	
			MAIL DATE	DELIVERY MODE
			11/29/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/511,633	Applicant(s) KAWA ET AL.	
	Examiner Danielle Sullivan	Art Unit 1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/18/2004</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "system" is indefinite. One of ordinary skill would not be able to discern if applicant is claiming a method or an apparatus, because system can pertain to a series of steps or a device. It appears applicant is claiming a dispenser for the composition claimed and claims are interpreted as such. Claims 22-33 are rejected for being dependent on a rejected base claim.

Claim 24 recites the limitation "comprises other surfactants (d)" in reference to claim 21 which identifies (d) as UV protection factors. There is insufficient antecedent basis for this limitation in the claim.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21, 23, 24, 26-28, 34, 36, 37 and 39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 5, 7 and 8 of U.S. Patent No. 7,285,283 in view of . Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition is disclosed as w/o and o/w emulsions contain: (a) polyol poly-12-hydroxystearates, (b) oil compartments selected from the group of dialkyl ethers, dialkyl carbonates, glycerides, hydrocarbons and silicone oils or mixtures thereof and (c) 5 to 25 % by

weight of water (column 2, lines 25-31). The composition may additionally contain surfactants such as Cocamidopropyl Betaine (zwitterionic surfactant) and sulfocuccinates (anionic surfactant) (column 9, lines 3-5 and 29). The emulsions may contain other auxiliaries and additives, including UV protection factors (column 9, lines 55-62). Klein teaches a topical composition, comprising 20% to 50% water, for use on skin which produces a foam when packaged in the form of an aerosol or a non-aerosol foam-forming closure system (abstract; column 2, lines 7-10; column 6, lines 3-6). The composition may contain the surfactants cocamidopropyl betaine and sulfosuccinates (column 2, line 53; column 3, line 43). Propellants used in preparing the aerosols include liquefied gases, nitrogen or carbon dioxide (column 6, lines 6-11). The fact that the composition is disclosed anticipates the system for dispensing it because compositions are often applied in the form of a spray or foam in order to achieve a soapy bubbly texture.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loehl et al. (US 6,482,418) and Ansman et al. (US 6,264,961) in view of Siegfried et al. (US 5,989,527) and Klein et al. (US 4,305,936).

### **Applicant's Invention**

Applicant claims a composition comprising:

- a) 2 to 10% by weight of at least one polyol poly-12-hydroxystearate (poly(12-hydroxystearate)polyglycerol ester),
- b) 1 to 20% by weight oil components (comprising dialkyl carbonates),
- c) 0.5 to 10% by weight other surfactants (a mixture comprising Cocamidopropylbetaine and sulfosuccinates),
- d) 0.5 to 20% by weight UV protection factors (sun protection factors)
- e) optionally auxiliaries and additives and
- f) 30 to 80% by weight water. The composition further comprises a w/o emulsion. Applicant further claims the aqueous emulsion whereby, the foamability is improved.

Applicant also claims a system for dispensing the composition as a foam by pumping air or a blowing gas into the composition.

### **Determination of the scope and the content of the prior art**

#### **(MPEP 2141.01)**

Loehl et al. teach cosmetic formulations comprising dialkyl carbonates and emulsifiers (abstract). Emulsifiers include polyglycerol poly-12-hydroxystearate (column 3, line 36) and Cocamidopropyl Betaine (column 5, line 3) and are preferred (column 5,

lines 21-23). The formulations may also contain superfatting agents, stabilizers, UV filters, etc. as further auxiliaries and additives (column 5, lines 39-47).

Ansmann et al. teach pumpable o/w emulsions that are pumpable and contain polyol polyhydroxystearates (emulsifiers) and surfactants (abstract). Polyol polyhydroxystearates are esters of polyols and polyhydroxystearic acids, derived from glycerol, such as polyglycerol poly-12-hydroxystearate (column 4, lines 16-18; column 8, lines 18 and 19). The o/w emulsifiers may contain further auxiliaries and additives, for example surfactants, oils, co-emulsifiers, preservatives and dyes (column 6, lines 1-5).

Siegfried et al. teach a variety of topical formulations in the form of an emulsion (water-in-oil or oil-in water) dependent upon the components of the composition (column 12, lines 52-60).

Klein teaches a topical composition, comprising 20% to 50% water, for use on skin which produces a foam when packaged in the form of an aerosol or a non-aerosol foam-forming closure system (abstract; column 2, lines 7-10; column 6, lines 3-6). The composition may contain the surfactants cocamidopropyl betaine and sulfosuccinates (column 2, line 53; column 3, line 43). Propellants used in preparing the aerosols include liquefied gases, nitrogen or carbon dioxide (column 6, lines 6-11).

**Ascertainment of the difference between the prior art and the claims**  
**(MPEP 2141.02)**

Loehl et al. and Ansmann et al. do not teach a w/o emulsion. Loehl et al. and Ansmann et al. do not teach that the composition is a foam dispensed by a manually

operated foam dispenser by pumping with air or a blowing gas in a specific mixing ratio, shot volume having a specified structure.

### **Finding of prima facie obviousness**

#### **Rationale and Motivation (MPEP 2142-2143)**

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Loehl et al., Ansmann et al. and Siegfried et al. to further include a w/o emulsion. One would have been motivated to include a w/o emulsion because there is more water within the emulsion and more water increases the property of foamability. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Loehl et al., Ansmann et al. and Klein to further include the composition in the form of a foam dispensed by a manually operated dispenser by pumping. One would have been motivated to include the manual dispenser because the foam would be desired at time of application to skin since bubbles would eventually break down and foam structure would be lost, thus losing desired consistency.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, reading "Danielle Sullivan". The signature is written in a cursive, flowing style.

Danielle Sullivan  
Patent Examiner